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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,342	12/06/2000	Benjamin Wiegand	JBP-529	9185

7590

11/05/2002

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 11/05/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/731,342

Applicant(s)

WIEGLAND ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 & 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 16, 2002 has been entered. Claims 1-9 and 11-20 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 20 recite terms "antiinfective" "shaving preparations", "poison ivy products" "poison oak products" "burn products" "anti-diaper rash agents" "prickly heat agents", "sensates", and "make-up preparations", which are referred as "benefit agents". These terms are not defined in the specification, and thus the metes and bounds of the scope of the claims are unascertainable.

Claims 1 and 20 are also objected to because the claims repetitively recite terms such as "vasoconstrictors", "amino acid agents", and "amino acid and their derivatives".

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There also seems to be a typographical error in reciting the terms “fragrances counterirritants” in those claims.

The remaining claims are rejected as depending on indefinite base claim.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 2, 3, 11-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman. (Global Cosmetic Industry, vol. 162, n. 2, pp. 22 and 24) in view of Santora et al. (US 6046145) and Marin et al. (US 5320783).

Herman discloses that the basic components of a ringing gel formulation are oil, water, a surfactant, and a cosurfactant. See p. 22, 1<sup>st</sup> col., the paragraph bridging cols.1 and 2. See col. 2 penultimate paragraphs where the surfactants are mixtures that read on claims 1(a) and 20 (a). The oil phase reads on claims 1(b) and 20(b).

While the reference teaches the general applicability the “ringing gel” for personal care compositions, the specific additives are not mentioned. See p. 22, 1<sup>st</sup> col., 1<sup>st</sup> paragraph and p. 22, 1<sup>st</sup> col., 1<sup>st</sup>.

Herman further teaches that multiple surfactants may be used to render wide distribution of surface-active properties, with examples of using different moles of ethoxylates. Using nonionic surfactant, polysorbate 20 to mix with fragrance oil, is also disclosed. The reference fails to teach using the amphoteric and anionic surfactants recited in the instant claims.

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Santora et al. teach a cleansing and moisturizing surfactant compositions comprising nonionic, amphoteric, and anionic surfactants in the amount of 5-20 % by weight and humectants in 0.01-3 % by weight, see col. 2, lines 14 – 32. Instant claims 10, 13-15 are met by this disclosure. The surfactants of claims 2 and 3 are disclosed in col. 3, line 22 – col. 5, line 12 and in col. 7, line 8 – col. 9, line 29. The surfactant system is said to provide mildness, non-greasiness, and non-irritating effects upon application to skin or hair, and provides good cleansing and moisturizing action. See col. 1, line 13 – col. 2, line 59. The mildness to eyes is especially emphasized. Addition of fragrance, coloring agents, and chelating agents is also disclosed, meeting claim 1. The composition comprising water in the amount of 58.22 – 70.5 % by weight is disclosed, which meets claim 11. Claim 12 is also rejected because a skilled worker would have discovered the optimum or workable ranges of water amount by routine experiments, motivated to produce a less viscous or diluted composition. The method of depositing the benefit agents is necessarily practiced by topically applying the composition as taught.

Martin et al. disclose a hexagonal liquid crystal compositions comprising oily phase, surfactant systems, and water, which may be used for hand cleanser or shampoo. See col. 8, lines 1 – 23. Col. 1, lines 44 – 64 teach that the composition may contain 20-70 % by weight of water, meeting claims 11 and 12. Claims 13-14 are met by the teaching that 15-70% of surfactant is used. It is further disclosed that using this range of the surfactant system is necessary in order to keep the hexagonal phase in desired viscosity. See col. 2, lines 31 - 46. The additives including perfumes,

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antimicrobial agents, and coloring agents, are disclosed, meeting claim 15, see col. 7, lines 17 – 28. Claim 17 is met by the disclosure that the invention may apply to hand cleaners or shampoos, as mentioned above. The surfactant system contains ethoxylated alkyl sulfate surfactants, and the inventors further teach that secondary surfactants or other types of anionic surfactants, and amphoteric surfactants, with particular mention of alkyl and amido betaines, may be included. See col. 5, lines 37 – 49. The reference teaches that the gel composition provides good viscosity, foaming, stability, appearance and cleaning ability. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Herman and add the surfactants and cosmetic actives as suggested by Santora and motivated by Marin because of the expectation to have successfully produced a mild and non-greasy skin or hair care compositions with viscosity, stability, appearance, and good cleansing effects.

(B) Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman, Santora et al., and Marin et al., as applied to claims 1-3, 11-17, and 20 above, and further in view of Greenburg et al. (U.S. Pat. No. 4,940,577).

The combined references lack the teaching of the limitations on oily phase as instant claims 4-8. Although Herman teaches that ringing gel requires oily phase and high level of surfactants, he fails to teach the amount of these components as required by instant claim 9.

Greenberg et al. teach a cosmetic composition comprising water-in-ester microemulsion with sunscreen additives and other cosmetic actives. About 2-15 % of emulsifiers and about 20-90% by weight of esters are used. See col. 2, lines 47 – 60. Greenburg et al. teach that a ringing gel composition requires 40-50% by weight of surfactants, col. 1, lines 13 - 16. For the oily phase, the esters including tridecyl stearate, tridecyl trimellitate, or neopentyl glycol dicaprylate/dicaprate, are disclosed, meeting claim 6. See col. 2, lines 31 – 43. Claims 4, 5, 7, 8 are also met because the HLB value and viscosity limitations of these claims are physical properties of the selected oils themselves. The reference teaches that the resulting composition is a clear microemulsion with a smooth and non-tacky feel. See col. 1, lines 13 – 61. For claim 9, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experiment.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references and used the esters as taught by Greenberg et al. because of the expectation to have produced a clear microemulsion skin care composition with a smooth and non-tacky feel.

(C) Claims 1, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman in view of Piechota (U.S. Pat. No. 5,256,396).

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Herman is discussed above. The reference lacks the teaching of using the composition to treat acne.

Piechota teaches topical ringing gel composition. He teaches that his invention is applicable to topical delivery of active ingredients, including retinoids for acne treatment or antiseptic or antimicrobial agent. See col. 4, lines 28 – 43. The method of depositing the benefit agents is necessarily practiced by topically applying the composition as taught.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Herman's composition by adding retinoids or antimicrobial agents and used it to treat acne, as taught by Piechota, because of the expectation of successfully producing a ringing gel composition that may be used for acne treatment.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9 and 11-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

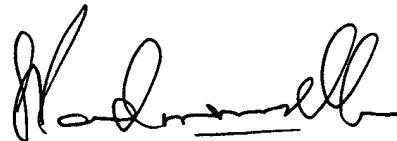


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308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
November 4, 2002



SREENI PADMANABHAN  
PRIMARY EXAMINER

11/4/02